

*REMARKS/ARGUMENTS**Claim Amendments*

Claim 5 has been amended to correct an editing inconsistency. Thus, “R₂ is hydrogen” has been moved a few lines down the page to avoid any confusion with the description of R₁. The claim amendment adopts the Examiner’s recommendation from the interview so as to place the application in condition for allowance. Accordingly, entry of the amendment is requested. No new matter has been added.

Withdrawn claims 16, 17, 31, 32, 40, 41, and 59-64, which are dependent upon elected invention claims, are available for rejoinder.

Examiner Interview

Applicants wish to thank Examiner Cecilia Jaisle, J.D. for the courtesies extended to Xavier Pillai, one of Applicants’ attorneys, during the telephone interview held on July 15, 2008 to discuss the rejections set forth in the Office Action. In regards to the written description rejection of claims 1 and 5, the Examiner confirmed that Applicants are entitled to claim less than the original disclosure and also asked Applicants to provide a more detailed discussion of the support for the claim amendment. In regards to the indefiniteness rejection of claim 5, the Examiner confirmed that if the claim was amended to move the description of R₂ to a few lines down the page, the rejection would be removed.

Office Action

Claims 1-15 and 49-58 are rejected under 35 USC 112, first paragraph, for an alleged lack of written description and claim 5 is rejected under 35 USC 112, second paragraph, for an alleged indefiniteness.

*Discussion of Rejections**1. Written Description*

The Office Action states that there is no support in the specification as filed for the proviso in claim 1: “when R₁ or R₂ is alkyl, R₃ is not a phenyl group substituted with a

halogen or a cyclic group having at least one 5-membered heterocyclic ring substituted with a halogen.”

Applicants respectfully disagree with the rejection. As agreed by the Examiner during the interview, Applicants are entitled to claim less than the original disclosure. The original disclosure provides for R₁ and R₂ to be alkyl and R₃ to be a phenyl group or a cyclic group having at least one 5-membered heterocyclic ring that is substituted with a number of groups, the halo substituent being one of them. Applicants are excluding from the scope of the claimed invention compounds wherein either R₁ or R₂ is alkyl and R₃ is a halo phenyl or a cyclic group having at least one 5-membered heterocyclic ring that is substituted with a halo group, said compounds clearly falling within the original disclosure. The claimed invention does not violate the written description requirement of 35 USC 112, first paragraph. The claim amendment is consistent with the case law. For example, see *In re Johnson*, 194 USPQ 187 (CCPA 1997).

The *Johnson* case is authority for the proposition that if the applicant has a genus and some species, he or she ought to be able to claim the genus minus the disclosed species. The invention in *Johnson* related to linear thermoplastic polyarylene polyether polymers composed of recurring units of two precursor compounds, both bonded to ether oxygens through aromatic carbon atoms. *Id.* at 1009-10, 194 USPQ at 188. Johnson’s first application was filed in 1963. During prosecution, the application became involved in an interference that resulted in an award of priority adverse to him. In 1972, Johnson filed a CIP application seeking to exclude the subject matter of the lost counts. Specifically, he amended his claims to recite that the two precursor compounds “may not both include a divalent sulfone group and may not both include a divalent carbonyl group.” *Id.* at 1013, 194 USPQ at 191.

The claims were rejected by the examiner under § 103 in view of a 1965 Dutch patent. The examiner reasoned that Johnson was not entitled to the 1963 filing date of his grandparent application because the subject matter of the claims of the 1972 CIP was not described in the grandparent. *Id.* at 1014, 194 USPQ at 192. The Board affirmed, adding that the artificial subgenus that Johnson created in his 1972 CIP was not described in his 1963

grandparent, and would be “new matter” if introduced into either the grandparent or the CIP. *Id.*

The CCPA reversed the Board, observing that the only inquiry was whether, after exclusion from the original claims of two species specifically disclosed in the 1963 application, the 1963 disclosure satisfied § 112, first paragraph, for the limited genus claimed in the 1972 CIP. *Id.* at 1017-18, 194 USPQ at 195. The court noted that Johnson was simply claiming less than the full scope of his disclosure, a perfectly legitimate procedure since it is for an inventor to decide what bounds of protection he will seek. The CCPA thus concluded that the examiner’s rejection was nothing more than a “hypertechnical application of legalistic prose” relating to § 112. *Id.* at 1019, 194 U.S.P.Q. at 196; see also *In re Driscoll*, 562 F.2d at 1249, 195 U.S.P.Q. at 438 (another case in which the CCPA criticized the PTO for a “hypertechnical application” of the written description requirement). Thus, this case illustrates that an inventor may excise the prior art from the claim and still satisfy the written description requirement of § 112, first paragraph.

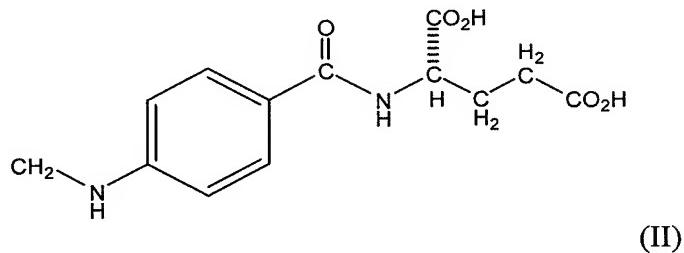
In view of the foregoing, claim 1 is fully supported by the application.

In regards to the rejection of claim 5, the Office Action states that there is no support for the new definition of R₃. Applicants respectfully disagree. In the Reply filed on February 1, 2008, Applicants had merely rewritten claim 5 in an independent form so as to put the claim in condition for allowance. Claim 5, prior to the amendment, depended upon claim 4, which in turn depended upon claim 3, which was dependent upon claim 2. The earliest claim making a reference to R₃ in claim 5 was claim 2. Accordingly, the description of R₃ as found in claim 2 (as originally filed; see Preliminary Amendment) was included in the rewritten claim 5. As such, no new matter has been introduced. It is to be noted that claim 5 is limited to compounds wherein R₁ is hydroxymethyl, carboxyl, formyl, or a group of formula (II). Accordingly, the claim does not require the provisos of claim 1, which address situations where R₁ or R₂ is hydrogen or alkyl, said situations being not possible with the subject matter of claim 5. Accordingly, the provisos were not included in claim 5.

In view of the foregoing, the written description rejection should be removed.

2. *Indefiniteness Rejection*

The Office Action rejected claim 5 alleging that it is not understood what is meant by the recitation: "R₂ is hydrogen;



(II);"

As discussed, Applicants have amended the claim to move the description of R₂ to a few lines down the page so as to separate it from the description of R₁, to which belongs the group of formula II.

In view of the foregoing, the indefiniteness rejection should be removed.

Conclusion

A favorable decision is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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